

REMARKS

Formal Matters

Claims 27-30 and 38-43 are pending after entry of the amendments set forth herein.

Claims 27-30 and 38-43 were examined and rejected.

Claim 43 is amended to incorporate subject matter from claim 27, the claim from which claim 43 depends. No new matter is added by this amendment.

Applicants respectfully request reconsideration of the application in view of the remarks made herein.

Allowable subject matter

Applicants gratefully acknowledge the Examiner's indication that claim 43, while being objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

Claim 43 is re-presented in independent form, including all of the limitation of claim 27.

Allowance of claim 43 is respectfully requested.

Rejections Under 35 U.S.C. § 102

Claims 27-30, and 38-43 are rejected as being anticipated under 35 U.S.C. §102(e) by Chi (WO0072255), having an effective filing date of June 11, 1999 and Christensen (WO0100849), having an effective filing date of June 29, 1999. Without wishing to acquiesce to the correctness of this rejection, the Applicants submit a Declaration under 35 U.S.C. § 131 to antedate the effective filing dates of both Chi and Christensen. Withdrawal of this rejection is respectfully requested.

As set out in 37 C.F.R. §1.131:

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§1.42, 1.43, or 1.47, *may submit an appropriate oath or declaration to establish invention of the subject matter of the rejected claim prior to the effective date of the reference* or activity on which the rejection is based. . . .

(b) *The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the*

invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.
(emphasis added)

The Applicants note that PARP activity assays are described in this parent of the instant application, on page 30, line 32 to page 31 line 2. As such, a §102(a) or §102(e) rejection may be withdrawn if the Applicants establish, by means of a declaration and a showing of facts, that the claimed subject matter was conceived prior to June 11, 1999 (Chi's filing date: the *earlier* effective filing date of Chi and Christiansen), and diligently reduced to practice from the period between June 11, 1999 and October 25, 1999, the filing date of a parent of the instant application.

In order to establish that the claimed invention was conceived prior to June 11, 1999, and diligently reduced to practice from the period between June 11, 1999 and October 25, 1999, the Applicants submit herewith the Declaration of Dr. Yasumichi Hitoshi under 37 C.F.R. §1.131.

The Applicants respectfully submit that Dr. Hitoshi's declaration and attached exhibits demonstrate conception of the claimed subject matter prior to June 11, 1999, and diligent reduction to practice between June 11, 1999 and October 25, 1999 for the following reason:

Exhibit A, dated prior to June 11, 1999, demonstrate that the Inventors had identified the sequence of the ADP-ribose polymerase domain of Tankyrase H and identified that Tankyrase H had poly(A) ribose polymerase activity. The Applicants respectfully submit that Exhibit A demonstrates that the Inventors had conceived the subject matter of the rejected claims prior to June 11, 1999.

Exhibit B, dated June 15, 1999, is a document disclosing that Tankyrase H has a PARP domain. The Applicants respectfully submit that this document demonstrates that Inventors diligently worked towards the subject matter of the rejected claims between June 11 and June 15, 1999.

Exhibit C sets forth a detailed description of experiments for identifying the full length sequence of Tankyrase H for use in the claimed screening assays. The Applicants respectfully submit that Exhibit C, showing the following dates: July 9, July 13, July 15, July 16 and July 21, 1999, demonstrates that the Inventors diligently worked towards the subject matter of the rejected claims between July 9 and July 21, 1999.

Exhibits D - H represent correspondence between Rigel (the assignee of the above-referenced patent application) and Rigel's patent counsel with regard to drafting of the above referenced patent

application. Exhibits D – H show the following dates: July 20, July 22, July 26, August 20, August 26, August 30, and September 30, 1999. The Applicants respectfully submit that this correspondence demonstrates that Rigel's patent counsel diligently worked on the above-referenced patent application between July 20, 1999 and its filing date October 25, 1999.

As such, since the filing date of a patent application may represent a constructive reduction to practice (see, e.g., MPEP § 2138.05), the Applicants respectfully submit that they conceived of the invention prior to the effective date of Chi (June 11, 1999) and Christensen (June 29, 1999) and diligently worked towards a reduction to practice of the invention between June 11, 1999 and October 25, 1999, the filing date of the instant patent application.

Accordingly, since the Applicants have provided an appropriate declaration and showing of facts that establish conception of the invention prior to the effective dates of Chi and Christensen coupled with due diligence from prior to the effective dates of Chi and Christensen to filing of the application, this rejection this rejection may be withdrawn.

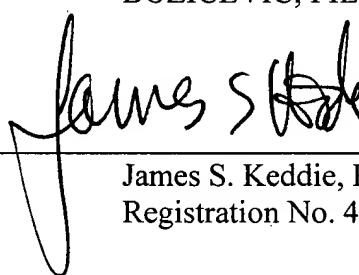
CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-010CIP2.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: 09/08/2004

By: 

James S. Keddie, Ph.D.
Registration No. 48,920

BOZICEVIC, FIELD & FRANCIS LLP
200 Middlefield Road, Suite 200
Menlo Park, CA 94025
Telephone: (650) 327-3400
Facsimile: (650) 327-3231

Enclosures: Exhibits A-H

Hitoshi Declaration